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In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 747

HAROLD L. MACK,
Petitioner,

vs.

EDWARD J. BRENNER,
Commissioner of Patents,
Respondent.

Petition for Writ of Certiorari To the United States Court of Customs and Patent Appeals

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To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Petitioner Harold L. Mack of Carmel, California, prays that a Writ of Certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals made in Appeal No. 7387 on May 6, 1965.

A certified transcript of the Record in this case accompanies this Petition, the references to the same herein being made to the number of the page as R. and to the Printed Record as PR. with the page number.

CITATIONS TO THE OPINION BELOW

The Opinion of the Court of Customs and Patent Appeals (R. 3-5) is reported in 52 CCPA ..... and unofficially in 344 F.2d 719; 145 USPQ 397 and 819 O.G. 26.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on May 6, 1965 (R. 3). A timely Petition for Rehearing was filed (R. 7) and was denied June 24, 1965 (R. 7). In accordance with the Rules of this Court an application was made for an extension of time in which to file this Petition for a Writ of Certiorari and was granted to and including November 21, 1965, by this Honorable Court on September 21, 1965 (Mr. Chief Justice Warren). The jurisdiction of this Court is invoked under the provisions of 28 U.S.C. Section 1256.

THE QUESTIONS PRESENTED

Three questions are presented:

1. Is it a proper denial of patent property to rely solely upon language of the patent claims of a prior patent (R. 4) which language is inconsistent with the language of the specification (Davidson PR. 45-52), and broader than the invention disclosed, in refusing the issuance of a patent on the ground of anticipation under 35 U.S.C. Section 102?

2. Is Petitioner properly denied the property right of an issued patent under 35 U.S.C. Section 102 when it is admitted that the invention which is sought to be patented was not described in the earlier issued patent [Davidson (PR. 45-52)] relied upon by the Patent Office but when it is asserted that they are "inherent" therein?

3. Should this Court exercise its supervisory powers in the protection of all citizens where it appears that an appellate court (the Court of Customs and Patent Appeals) has issued an Opinion

which is a *non sequitur* and because of a complete breakdown in the judicial function, does not decide any issue presented to it for decision?

STATEMENT OF THE CASE

This case arose on an *Ex parte* Appeal from the holdings of the administrative agency, the Patent Office in refusing to issue a patent to the Petitioner, Harold L. Mack (PR. 17, PR. 33). Petitioner elected to take his Appeal to the Court of Customs and Patent Appeals pursuant to 35 U.S.C. Section 141 (PR. 41). Respondent is Edward J. Brenner, Commissioner of Patents represented by the Solicitor for the Patent Office.

The application for a patent was made by Petitioner July 11, 1960. The claims were finally rejected June 7, 1962 (PR. 17) under 35 U.S.C. Section 102 upon a single U.S. prior patent to Davidson (PR. 45-52) as an anticipation. An Appeal was made (PR. 17) to the Patent Office Board of Appeals on June 25, 1962 and the sole issue was whether or not the prior patent (Davidson, PR. 45-52) described Petitioner's invention. If it did not, then Section 102 provides that Petitioner "shall be entitled to a patent". On September 12, 1963 the Patent Office Board of Appeals rendered a decision that the articles and methods claimed do not appear to patently distinguish over the single prior patent and "the stated rejection is affirmed" (PR. 35). No issue of lack of patentability because of obviousness under 35 U.S.C. Section 103 was involved or argued on the appeal (PR. 17). However, the Board had stated earlier in its Opinion (PR. 35) that the Davidson patent teaches persons of ordinary skill in the art the subject matter of Petitioner's invention. This was mere *obiter dicta* as no question of rejection under Section 103 was involved or in issue and was not included in "the stated ground" of the Examiner's refusal which was affirmed. On the Appeal to the Court of Customs and Patent Appeals in a shoddy, ill-considered and incomplete Opinion (R. 3-5), the Court of Customs and

Patent Appeals affirmed the refusal of the patent, not only on the ground of anticipation under Section 102, but on the ground that the prior patent rendered the claims obvious to persons of ordinary skill in the art under Section 103 (R. 3-5). The Opinion affirmed also on the basis that Davidson disclosed a "filter" and so the inventions were identical under 35 U.S.C. Section 102 (R. 5). It is apparent that Petitioner's invention is not a filter for cigarettes *per se*, but a filter treated and prepared in a certain way to accomplish new results. All of this was in spite of the fact that the Brief for the Commissioner of Patents made the express admission that:

> "The [Petitioner's] claims specify features of such a method, and the filter produced, which are not described by Davidson [PR. 45 to 52]. The question is whether these features are inherent in Davidson, and therefore anticipated under 35 U.S.C. 102, or would be obvious under 35 U.S.C. 103."

Within the limits of the times prescribed by the rules, Petitioner filed a Petition for Rehearing which was denied June 24, 1965 (R. 7).

The subject matter of the claims relates to cigarettes which have filters capable of removing the harmful tars and nicotines from the smoke during the course of smoking. It was well-known at the time Petitioner filed his application that such filters also removed the tobacco taste and flavor from the smoke. It is Petitioner's invention to re-establish the tobacco flavor to the smoke by treating the filter so as to impart to the smoke the original tobacco flavor without the harmful products of combustion. It is apparent from reading the only prior art patent involved, i.e., Davidson (PR. 45 to 52), that it was not directed to and did not—and could not solve this problem.

It is also important to note that after Petitioner had submitted his invention to the Patent Office and after adverse rulings in the

Patent Office, the American Tobacco Company first came out with *Montclair* Cigarettes which added menthol to the filter (PR. 18 and 19) and recently has changed its whole line of *Lucky Strike* Cigarettes to precisely that of Petitioner's invention, advertising in each instance that this had been done for the first time and even went so far as to file their own patent application directed to this subject matter (PR. 18). Thus, we have the concomitance of admissions by the Patent Office and one of the biggest factors in the industry, that there was neither anticipation under 35 U.S.C. Section 102 nor obviousness of subject matter under 35 U.S.C. Section 103.

REASONS FOR GRANTING THE WRIT

The Petition presents important questions with respect to the proper interpretation and application of Sections 102 and 103 of the Patent Act of 1952 which up to date have not been acted upon by this Court and concerning which the entire patent profession and industry await direction and guidance.

The Petition advances a question related directly to the obligation of the Patent Office to issue patents pursuant to the express statements of 35 U.S.C. Section 102 and the breach of this obligation under the present ruling which not only refuses the issuance of a patent, but does so on the basis of language contained in the claims of a prior patent, all of which are contrary to the decisions of this Court. Precisely, the question is—is it the specification which is used as the anticipatory matter under Section 102, or is it the claims. This Court has held it is the specification and not the claims which determines anticipation.

In *Alexander Milburn v. Davis Co.*, 270 U.S. 390 (1926) the matter of the teaching or description of a prior application to Clifford as an anticipation of a subsequently filed application to Whitford was before this Court. In reversing this Court held: (p. 401-402)

> "It is said that without a claim the thing described is not reduced to practice. But this seems to us to rest on a false

theory helped out by the fiction that by a claim it is reduced to practice. A new application and a claim may be based on the original description within two years, and the original priority established notwithstanding intervening claims. *Chapman v. Wintroath,* 252 U.S. 126, 137. A description that would bar a patent if printed in a periodical or in an issued patent is equally effective in an application so far as reduction to practice goes."

* * * * * * *

"The fundamental rule we repeat is that the patentee must be the first inventor."

In *Minerals Separation v. Magma Copper,* 280 U.S. 400 (1930) the court decided that the effect of a patent as a disclosure depends on what is made known by the specification and is not limited by the precise scope of its claims. The description of the anticipating patent included oils, fatty acids and *other* substances which have an affinity for metalliferous matter, but the claims were limited to oils. The patent in suit was directed to a water soluble substance having an affinity for metalliferous matter. In affirming the anticipation the Court held: (p. 404)

"The patent having been held good as to the oils although experiment was necessary to find out what oil would work best with a given ore, the disclosure was an anticipation although experiment might be necessary to choose among the substances having the required affinity the one that would produce the best result."

The Court of Customs and Patent Appeals has refused to apply the pertinent decisions of this Court and has refused to follow them. The decision is also in conflict with its own prior holdings. *In re Application of Smolak,* 24 CCPA 1132; 88 F(2) 838; 33 USPQ 217 (1937) referred to the holding in *In re Downs et al,* 18 CCPA 803, 807; 45 F(2) 251; 7 USPQ 316 where it followed the Supreme Court's views in *Minerals Separation v. Magma Copper (supra)* that anticipation is not to be determined

from the claims made in the reference, but upon the description of the respective specification. This Court, having spoken on this subject prior to the Patent Act of 1952, it is now necessary to determine whether Section 102 of the Act is a codification of this Court's holdings, or something new and different. This question, of course, is of great importance to the public and particularly to industry in general and to the Patent Office.

The Petition also presents the question under the Patent Act of 1952 whether a patent may be refused by the Patent Office under 35 U.S.C. Section 102 where the Petitioner's invention is not described in the alleged anticipating patent but where it is asserted that the features of Petitioner's invention are inherent in the earlier patent to Davidson. This Court has uniformly held that the accidental production of a result or the use of a device or process not recognized as important or understood by the producer, does not anticipate a later device for the same thing made by one who discovers the principle and puts it into use

Tilghman v. Proctor, 102 U.S. 707; 26 L.Ed. 279 (1881).

Ansonia Brass v. Electrical Supply, 12 Sup. Ct. 601, 144 U.S. 11; 36 L.Ed. 327 (1892).

Eibel Process v. Minnesota, 43 Sup. Ct. 322; 261 U.S. 45; 67 L.Ed. 253, at page 66:

> "In the first place we find no evidence that any pitch of the wire, used before Eibel, had brought about such a result as that sought by him, and in the second place if it had done so under unusual conditions, accidental results, not intended and not appreciated, do not constitute anticipation. *Tilghman v. Proctor,* 102 U.S. 707, 711; *Pittsburgh Reduction Co. v. Cowles Electric Co.,* 55 Fed. 301, 307; *Andrews v. Carman,* 13 Blatchf. 307, 323."

Prior to the Patent Act of 1952 this Court has uniformly held that inherent results unintended and not appreciated do not constitute anticipation which would require the refusal of a patent

under the interpretation of 35 U.S.C. Section 102. The Court of Customs and Patent Appeals has refused to follow this Court's holdings made prior to the Patent Act of 1952. It is therefore necessary that this Court should exercise its supervisory power to bring this holding into line and in conformity with the opinions formerly given, and the law as it is understood.

The Petition further presents the question of whether the Court of Customs and Patent Appeals may continue to deny substantial property rights in the form of patents with opinions and judgments which do not decide issues which are raised.

In its Opinion (R. 3-5) the Court of Customs and Patent Appeals merely decided that the Davidson prior patent referred to a filter. This was only a preliminary facet and is a *non sequitur* in and of itself. Assuming, *arguendo* only, that Davidson did refer to a filter, the matter at issue was did it describe the same kind of a filter as required by Petitioner and did it also describe the treatment of such a filter as claimed by Petitioner. These issues before it were not even considered.

In modern times no Petition for a Writ of Certiorari directed to the United States Court of Customs and Patent Appeals had been granted until April 26, 1965, and then only at the behest of the Commissioner of Patents (No. 932, *Brenner, Comr. Pats. v. Manson*). It is believed that since the Judiciary Act of February 13, 1925, 43 Stat. 936, the writ directed to the Court of Customs and Patent Appeals has never been granted at the behest of a private citizen. It is long past time for this Court to exercise its supervisory powers to end the ever growing belief that the Court of Customs and Patent Appeals is a law unto itself, and responsible to no one.

The only recourse which a litigant has to make certain that the Court of Customs and Patent Appeals does its work in a fair, impartial and workmanlike manner is to petition this Court. It is necessary for this Court to act because the Opinion referred

to does not reach a reasonable or permissible result. Because the Court of Customs and Patent Appeals is a Court of last resort for many patent litigants, such a result, as well as the manner of reaching it, has a strong tendency to undermine and degrade our system of justice, and so it is of great importance to every citizen.

Respectfully submitted,

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(Appendix Follows)

Appendix

United States Court of Customs and Patent Appeals

October Term 1964.

Patent Appeal No. 7387.

Serial No. 41,804.

IN THE MATTER OF THE APPLICATION
OF
HAROLD L. MACK

May 6, 1965

Martin, Judge.

Appellant claims a tobacco flavored cigarette filter, and a method of treating smoke filters with a tobacco flavored additive in his application serial No. 41,804, titled "Cigarette Treatment and Product," which was filed in the Patent Office July 11, 1960.

A claim, representative of claims 1-5, which were finally rejected by an examiner as "unpatentable over" or "met" by [Cf. PR. 17] a patent to Davidson, 2,164,702, issued July 4, 1939, reads as follows:

> 2. A method of treating filters for cigarettes, which filters are of the type that remove tar and nicotine from cigarette tobacco smoke comprising adding several drops of tincture of tobacco flavored to taste to a filter in order to restore to the tobacco smoke the flavor removed as a result of the removal of tar and nicotine.

The board, affirming the examiner, held that the following disclosure of Davidson "anticipates" the claims or "renders them obvious to persons of ordinary skill in the art":

> In Fig. 1 is shown a cigarette having the usual wrapper 15 and tobacco filler 16 and also having at one end within the wrapper 15 a filter plug or mouthpiece insert 17.

* * *

> Preferably the paper or other material constituting the above described fillers is so constituted or treated as to be fire resistant or self-extinguishing, and is suitably sized. In addition, the material may be treated by coating or, in the case of soft sized paper, saturating the same with an infusion made from tobacco, tobacco stems, cocoa, cinnamon, menthol or other flavoring materials. [Emphasis supplied.]

The sole distinction which appellant urges [Cf. PR. 41-43] is that the "mouthpieces" of Davidson are fillers rather than filters, in part evidenced by the above underlined discrepancy in the reference. It is further urged that the "mouthpieces" cannot function as filters since the folds of the paper material are such that there are, in appellant's words, "uninterrupted longitudinal air passages therethrough," i.e., no smoke-laden air is drawn *through* paper such that it would act as a filter. Thus appellant urges, Davidson is not an anticipation in the sense of a full disclosure.

While elsewhere in Davidson the paper used to form the mouthpieces is referred to as "paper filler" and "filler" any doubts we have that the mouthpiece is indeed a filter are resolved by Davidson's claim 11:

> 11. A method of making filter plug mouthpieces for cigarettes, which comprises forming a smoke filter having multitudinous generally longitudinal passages by laterally loosely compressing together, through pressure applied radially inward into substantially cylindrical form, fibrous cellulose material, and simultaneously moving said material in the axial direction of the cylinder so formed.

The axial passages in the Davidson filter do not prevent it from functioning as a filter, and appellant discloses no particular filter structure such that any distinction as to novelty within the meaning of 35 USC 102 can be urged.

The decision of the board is *affirmed*.

AFFIRMED

Smith, J., concurs in the result.